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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,248	07/25/2005	Philip A. Block	60285-USA1	6684

7590 04/10/2008

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EXAMINER	
LAWRENCE JR, FRANK M	

ART UNIT	PAPER NUMBER
1797	

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04/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,248	BLOCK ET AL.	
	Examiner	Art Unit	
	Frank M. Lawrence	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 December 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/20/08*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 9-12 and 14-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 14, 15 and 17-24 of copending Application No. 10/565,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending claims encompass and envision all of the limitations of the instant claims. One having ordinary skill in the art would understand that the composition would function to oxidize contaminants without the inclusion of hydrogen peroxide and that the composition can be used in effective amounts.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-22 and 27-30 of copending Application No. 10/518,249. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending claims encompass and envision all of the limitations of the instant claims. One having ordinary skill in the art would understand that the composition would function to oxidize contaminants without the inclusion of a pH modifying agent, that the composition can be used in effective amounts, and that iron and EDTA can be used as common catalyst and chelating agents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 9-11, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Newton (5,700,107).

6. Newton '107 teaches a method of soil remediation comprising adding a complexing agent that includes a chelating agent such as citric acid, a salt such as one of the chlorides of iron, and a persulfate such as sodium persulfate to remove pesticides and other contaminants (abstract, col. 1, lines 52-67, col. 2, lines 24-49, col. 4, lines 1-16).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 6-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newton '107.

9. Newton '107 discloses all of the limitations of the claims except that the peroxygen compound is a sodium or potassium monopersulfate or a combination of di-and monoperfulfate, and that preferred amounts of chelating agent and peroxygen compounds are used. It is submitted that one having ordinary skill in the art would know to use any available persulfate that is known in the art to be capable of oxidizing contaminants in soil based on the teaching of a sodium persulfate in the patent. Also, the amounts of peroxygen and chelating agents are considered to be parameters that would have been routinely optimized by one having ordinary skill in the art at the time of the invention based the nature of contamination and the desired level of decontamination.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton '107 in view of any one of Vineyard (6,576,144) or Watts et al. (5,741,427).

11. Newton '107 discloses all of the limitations of the claim except that EDTA is used as the chelating agent. Any one of Vineyard '144 or Watts et al. '427 discloses a method of oxiding contaminants in waste water comprising adding a peroxygen compound with an EDTA chelating agent. It would have been obvious to one having ordinary skill in the art to substitute EDTA for

the chelating agent of Newton '107 because it is known to be useful for same the purpose of facilitating contaminant remediation in the water.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton '107 in view of Hoag et al. (6,019,548).

13. Newton '107 discloses all of the limitations of the claim except that the chelating agent, transition metal, and peroxygen compound are added sequentially. Hoag et al. '548 disclose an in situ treatment method for soil remediation, comprising adding permanganate and persulfate to the soil either sequentially or together as an aqueous solution (see abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Newton '107 by adding the components sequentially in order to provide a method of treatment in the situation where a premix is costly or not readily available.

Response to Arguments

14. Applicant's arguments filed February 20, 2008 have been fully considered but they are not persuasive. Applicant argues that the double patenting rejections over 10/565,564 and 10/518,249 are improper because the co-pending applications disclose the use of additional elements such as a pH modifier and a peroxide compound, however it is submitted that one skilled in the art would understand that the compositions can still be useful without the additives.

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the reaction of the chelating agent with free radicals and the use of a chelated metal catalyst with persulfate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. The examiner agrees that Newton '107 fails to disclose the reaction of the chelating agent with free radicals and the use of a chelated metal catalyst with persulfate, however the anticipation rejection is maintained because the patent teaches every element recited in the claim.

17. The examiner agrees that the Vineyard and Watts et al. patents fail to disclose the use of persulfate and has withdrawn the anticipation rejections over those patents.

18. With respect to the Hoag et al. patent, the examiner has cited it for teaching that elements of a composition can be added sequentially or together and that one skilled in the art would have known to use sequential addition when a premix is prohibitive.

19. Note that the amendment to the specification is improper because amendment rules require that an entire paragraph or section must be replaced.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Lawrence whose telephone number is 571-272-1161. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank M. Lawrence/
Primary Examiner, Art Unit 1797

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